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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,321	03/01/2002	Hitoshi Matsumoto	1576.98	4553

7590

11/06/2003

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EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/070,321	Applicant(s) MATSUMOTO ET AL.	
	Examiner Olga Asinovsky	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al U.S. Patent 6,365,321.

The rejection is set forth at pages 2-4 of the office action mailed on June 4, 2003 and is incorporated here by reference.

3. Applicant's arguments filed Sept. 08, 2003 have been fully considered but they are not persuasive.

4. The applicants' argument is that Chen discloses a process including a step of polymerizing acetoxystyrene and ester compounds. Whereas the process described in the present claims 4 and 6 is for the preparation of the alkenylphenol copolymer and a

said process includes step of eliminating and/or decomposing only a specified amount of the group protecting the phenolic hydroxy group with an acid reagent. The argument is that the process described in the present claims 4 and 6 is different from the process disclosed by Chen (page 10 in the applicants' remarks). This argument is not persuasive because Chen claims and alternatively discloses (i) a hydroxystyrene copolymer comprising a first monomer that is a substituted or unsubstituted hydroxystyrene and a second monomer (meth)acrylic ester, and (ii) a phenolic polymer in claim 1 at column 13. The hydroxystyrene copolymer in the Formula (I) can be para-isomer and said hydroxystyrene, column 4, lines 40-48 and column 6, lines 15-16, is readable in the Formula (i) in the present claim 1. The p-hydroxy styrene is equivalent to a p-alkenyl phenol. The phenolic polymer can be a copolymer, column 6, lines 20-21. When the phenolic polymer is a copolymer of the formula (II) at column 4, the first monomer unit is a substituted or unsubstituted hydroxystyrene and the second monomer unit can be a differently substituted hydroxystyrene such that R3 can be alkoxy having 1 to about 8 carbon atoms, column 6, lines 26-32. The second monomer unit is readable in the present claims formula (II) or formula (IV). The phenolic polymers are prepared by anionic polymerization and have narrow molecular weight distribution, column 7, lines 17-20. A fraction of the free hydroxyl in the phenolic polymer is protected with a protecting group, claim 11 at column 14. The protected hydroxyl is protected with an acid-inert protecting group to give an OR moiety, claim 13 at column 14, that is readable in the present claims. Applicants' statement that the step of eliminating and/or decomposing only a specified amount of the group protecting the

phenolic hydroxy group with an acid reagent (page 10 in the applicants' remarks) is not persuasive since reference discloses that a phenolic polymer can be partially or wholly protected (abstract) and "the phenolic polymer consists of one, two or three monomers having free hydroxyl groups", claim 9 at column 13. Therefore, the phrase "specified amount of the group protecting the phenolic hydroxy group" would be readable in Chen's invention. The term "specified" amount is depending on the desired property of the obtained alkenylphenol copolymer.

The valence for the carbon atom in the formula (IV) and formula (V) in claims 3 and 5 should be corrected.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 703-308-0041. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Olga Asinovsky
Examiner
Art Unit 1711

O.A.

O.A.
October 27, 2003

Rabon Sergent
RABON SERGENT
PRIMARY EXAMINER